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09/560,222	04/28/2000	Paul Haerberli	11087-014001	3668
31688	7590	12/01/2003	EXAMINER	
TRAN & ASSOCIATES 6768 MEADOW VISTA CT. SAN JOSE, CA 95135			FADOK, MARK A	
			ART UNIT:	PAPER NUMBER
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DATE MAILED: 12/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Interview Summary

Application No.

09/560,222

Applicant(s)

HAEBERLI, PAUL

Examiner

Mark Fadok

Art Unit

3625

All participants (applicant, applicant's representative, PTO personnel):

(1) Mark Fadok.

(3) Mr. Wen (Shutterfly owner).

(2) Mr. Tran (applicant's attorney).

(4) _____.

Date of Interview: 26 November 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference

c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: _____.

Claim(s) discussed: 112 and 117.

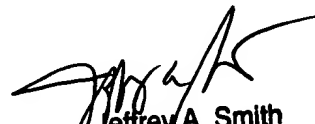
Identification of prior art discussed: Enomoto.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See comments.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.


Jeffrey A. Smith
Primary Examiner

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Based on a proposed amendment (attached) presented by Mr. Tran, an interview was conducted. Mr. Tran and Mr. Wen discussed the distinguishing features they felt overcame the prior art. The examiner asked if these features were presented in the claims. Mr. Wen argued that "suggesting by a computer" was analogous to a user pressing a single button to present different products to the buyer for subsequent purchase. The examiner stated that although this feature may be in the specification, the examiner was required to evaluate the claims given their broadest reasonable interpretation while not importing specific features from the specification that were not presented in the claim. The examiner suggested that the applicant might add additional features to claim 117, which the examiner described as very broad to further limit the claim. Mr. Tran asked if the current language as provided in the attached e-mail would be considered allowable. The examiner responded that he could not prosecute the case over the phone but would carefully consider any arguments and/or amendments filed in a formal response to Office Action mailed 10/22/2003. Mr. Tran also asked if the examiner had any suggestions to improve the claim language. The examiner concluding the interview suggesting that the applicant attempt to overcome the current art of record by adding to the claims those features, which they feel, are distinguishable over the prior art.

HAEBERLI

Application No.: 09/560,222

Page 1

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

HAEBERLI

Application No.: 09/560,222

Filed: 4/28/2000

For: SYSTEM AND METHOD OF
CHANGING ATTRIBUTES OF AN
IMAGE-BASED PRODUCT

Examiner: Fadok, Mark A.

Art Unit: 3668

**AMENDMENT AND RESPONSE TO
OFFICE ACTION**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sirs:

Please amend the claims as follows:

112. (Currently Amended) A method for providing computer suggested image processing on a first image, comprising:

~~identifying an attribute of a first image and suggesting by a computer;~~
~~— automatically selecting a new value, for a one of a plurality of product attributes of an image-~~
~~based product incorporating at least a portion of the first image, based on the image attribute; and~~
~~receiving an order for the image based product having the product attribute including the~~
~~automatically identified image automatically selecting a new value for the computer suggested~~
product attribute.

113. (No change) The method of claim 112, further comprising:
displaying the first preview image of the image-based product.

114. (No change) The method of claim 113, wherein displaying the first preview image of the
image-based product includes:
downloading the first preview image to a client computer; and
displaying the first preview image on the client computer.

115. (No change) The method of claim 112, further comprising uploading the first image from a
client computer to a server using a computer network.

116. (No change) The method of claim 112, further comprising receiving a selection of the first image from a plurality of images.

117. (Currently Amended) The method of claim 112, wherein the product attribute ~~of the first image~~ includes a color attribute of the first image.

118. (Currently Amended) The method of claim 112, wherein the product attribute ~~of the first image~~ includes an image border attribute of the first image.

119. (Currently Amended) The method of claim 112, wherein automatically identifying and suggesting the image product attribute includes analyzing the first image.

120. (Currently Amended) The method of claim 119, wherein [the] a new value for the product attribute is automatically selected based on the analysis of the first image.

121. (No change) The method of claim 119, wherein analyzing the first image includes generating a set of representative colors from the first image.

122. (No change) The method of claim 120, wherein automatically selecting the new value for the product attribute includes selecting a color as a function of at least one of the representative colors.

123. (No change) The method of claim 122, wherein selecting the color as a function of at least one of the representative colors includes selecting a color that matches at least one of the representative colors.

124. (No change) The method of claim 123, wherein selecting the color that matches at least one of the representative colors includes selecting a color that complements at least one of the representative colors.

125. (No change) The method of claim 122, wherein selecting the color as a function of at least one of the representative colors includes selecting the color from the set of representative colors.

126. (No change) The method of claim 125, wherein selecting the color from the set of representative colors includes selecting the most popular color.

127. (No change) The method of claim 125, wherein selecting the color from the set of representative colors includes selecting the color at random from the set of representative colors.

128. (Currently Amended) The method of claim 112, wherein the product attribute is a border color [product attribute] of the image-based product and ~~the a new~~ color value is ~~the selected color is~~ for the product attribute.

129. (No change) The method of claim 128, further comprising generating a second preview image of the image-based product having a border, wherein the color of the border is the color specified by the border color product attribute.

130. (Currently Amended) The method of claim 112, ~~wherein~~ further comprising selecting a new value for the product attribute [includes selecting the new value] at random.

131. (No change) The method of claim 130, wherein the selection of the new value is constrained based on previous values of the product attribute.

132. (Currently Amended) The method of claim 112, ~~wherein~~ further comprising selecting a new value for the product attribute [includes selecting the new value] at pseudo-random.

133. (Currently Amended) The method of claim 112, ~~wherein~~ further comprising selecting a new value for the product attribute [includes selecting the new value] from a predetermined ordering of values.

134. (No change) The method of claim 112, wherein the product attribute relates to which images are incorporated in the image-based product, and the image-based product further incorporates at least a portion of a second image.

135. (Currently Amended) The method of claim 112, further comprising:
receiving a plurality of images;
automatically identifying and suggesting by the computer one of a plurality of an image attributes of each of the received images; and
automatically selecting the first and second images from the received images based on the automatically identified and suggested image attributes of the received images.

136. (Currently Amended) The method of claim 112, further comprising fulfilling ~~the~~ an order for the image-based product having the computer suggested product attribute.

REMARKS

The Final Office Action rejected claims 112-114 and 136 under Section 102(e) as anticipated by Enomoto (5,974,401). Further, claims 115 and 117-135 were rejected as unpatentable over Enomoto in view of Official Notice. Claim 116 was rejected under Section 103(a) as unpatentable over Enomoto and Wain (6,298,197). Applicants respectfully traverse the rejections and respectfully submit that all claims are in condition for allowance.

The §102 Rejections

Claims 112-114 and 136 were rejected under Section 102(e) as anticipated by Enomoto. Enomoto relates to a digital print order and delivery method and system where an order sender processes the image data with reference to a display on the screen of a computer, and then inputs print order data. The print order data includes print option data designating size and number of prints, expected delivery date data, delivery option data designating the way of delivery, and user ID data for identifying the order sender. Then an order receiver or a particular photofinisher is designated. The processed digital image data and the print order data are sent to the designated photofinisher for printing.

Enomoto requires a user to operate a computer to perform the tasks of editing and ordering prints as follows:

Now the operation of the above embodiment will be described with reference to FIG. 3. The user 10 gets the list of photofinishers 25 on-line through the network 23 such as the Internet. The list 25 is obtainable by use of data communication software attached to the personal computer 11. Next, the user 10 selects the best photofinisher 12 from the list 25 taking into account which store is the nearest, what kind of print format is expected, how much the charge for print is, and what kind of delivery is possible, etc., and then taps into the Web site of the selected photofinisher 12 to connect to the data base 24 on the photofinisher side 12.

Upon user's request for downloading sent from the connected personal computer 11 on the user side 10, the work station 13 of the photofinisher 12 sends out the image processing-ordering software to the personal computer 11 of the user side 10. The user 10 extracts the downloaded image processing-ordering software and installs it in the personal computer 11. If the installation is accomplished normally, a user registration menu appears, which helps the user register for the print order.

In this user registration processing, the work station 13 publishes a user ID number and a password for the user 10. After that, the work station 13 can receive a print order just by checking these user ID number and password.

Next, the user 10 takes in the image data for print and carries out the image processing by using the image processing-ordering software. The image data is input into the personal computer 11 by the scanner 20, digital still camera and digital video camera without illustration. In addition, television images and video tape recorder images are input through a video capture board. Moreover, the image from the network 23 such as the Internet may be taken in as image data for print, if it is allowed to be printed.

The image data taken in is processed by the image processing-ordering software. Among the image processing techniques, for instance, there are gamma-correction, matrix correction, illustration-letter composition, magnification/reduction processing, trimming and image composition. After the image processing is complete, the processed image data is compressed, for example, by JPEG (Joint Photographic Experts Group) compression. The compressed image data is written in the fixed area of RAM of the personal computer 10. Not only JPEG, but also other well-known type data compression method are applicable.

Next, the user inputs the print order data. It is carried out through selecting the expected option data on the data input screen by using a mouse or a keyboard. After the input of all print order data is accomplished, the computer 11 of the user 10 moves to a data transfer mode, then it is connected to the work station 13 of the photofinisher 12 and a print pre-order data is sent through the data communication.

The print pre-order data consists of the print option data, the expected delivery date designation data and data of image data size or data quantity. These data pieces are included in the print order data.

Since the total number of presently accepted orders and the delivery dates thereof are managed in the work station 13, it is possible to calculate the earliest possible delivery date and the charge for the ordered prints according to the image data size and the number of prints designated by the pre-order data from the user 10 taking into account of the number of orders from other users and the processing ability or capacity of the photofinisher side 12. The delivery date and the charge calculated based on the pre-order data are sent with an accept number to the user side 10. That is, the work station 13 checks whether the delivery will be in time for the expected delivery date or not with reference to the pre-order data, and also calculates the time necessary for photofinishing the ordered prints. By adding the time taken for photofinishing to the time taken for delivery, the earliest possible delivery date is calculated.

If the calculated delivery date exceeds the expected delivery date, the work station 13 sends a message of unacceptance to the personal computer 11 of the user 10. In that case, the user 10 may change the expected delivery date and send the pre-order again, or may cancel the order.

If the calculated delivery date is within the expected delivery date, the work station 13 sends the accept number and a message of acceptance to the personal computer 11 on the user side 10. The work station 13 also requires the personal computer 11 to forward the entire print order data.

The user 10 selects or designates the order execution after confirming the delivery date and the charge on the screen, then the personal computer 11 sends the entire print order data to the work station 13. The entire print order data is constituted of all the print order data and the image data for print. The work station 13 controls the entire print order data based on the accept number, and stores it into the memory device 14.

The work station 13 makes prints in the order of delivery date based on the received print order data. At this time, the work station 13 selects one printer from the printers 15 to

17 based on the print option data, and makes prints based on the designated number of prints and print size. For instance, if the normal L size is designated, the printer 15 is selected to make L size prints 33. If the cabinet size is designated, the printer 16 is selected to make cabinet size prints 35. If the A3 size is designated, the ink jet printer 17 is selected to make A3 size prints 36. If the manual correction by operator is selected, the work station 13 selects a manual print processing within business hours, and does not carry out auto-printing. In this case, the operator carries out the image processing to provide the best density and color balance, then makes the prints 33, 35 or 36 by using the printer 15, 16 or 17. Also when those print sizes and print formats which are not available by auto-printing are selected, the manual print processing is carried out by the operator within business hours. Enomoto at Col. 5, lines 66-Col. 7, line 40.

As shown abundantly above, Enomoto requires a user to make all decisions. In contrast, claim 112 relates to a method for "COMPUTER SUGGESTED IMAGE PROCESSING" and the claims recite a method for providing computer suggested image processing on a first image by:

identifying and suggesting by a computer one of a plurality of product attributes of an image-based product incorporating at least a portion of the first image; and

automatically selecting a new value for the COMPUTER SUGGESTED product attribute.

Enomoto requires operations to be done manually by a user (e.g., where the user actuates one or more controls in order to select which product attributes to change and/or to select a new value for the selected attributes). In contrast, the claimed invention does not require user invention in the automatic selection of image attributes as follows:

As noted above, the system 100 can automatically select which product attributes to change and select new values for the selected product attributes. In one implementation shown in FIGS. 16 and 17A-17B, a user can cause the system 100 to automatically select which product attributes to change and the new values for the selected product attributes by actuating a user interface control such as a button. FIG. 16 is a flow diagram of process of causing a system 100 to automatically select which product attributes to change and the new values for the selected product attributes. First, a user interface control is displayed (block 1602). The user interface control can be any user interface element by which a user can initiate a command. Examples include a button, menu, menu item, command line, key sequence, selection box, and icon. Specification at Page 28, lines 5-14.

Here, Enomoto does not show identifying and suggesting by a computer one of a plurality of product attributes of an image-based product incorporating at least a portion of the first image.

Further, Enomoto does not show computer suggested image processing. This is another independent basis for traversing the Section 102 rejection. Additionally, Enomoto does not show automatically

selecting a new value for the COMPUTER SUGGESTED product attribute. This is yet another independent basis for traversing the Section 102 rejection.

Since the independent claim is not anticipated by Enomoto, none of the dependent claims can be anticipated by Enomoto. Withdrawal of the rejection under Section 102(e) as anticipated by Enomoto is respectfully requested.

The §103 Rejections

Claims 115 and 117-135 were rejected as unpatentable over Enomoto in view of Official Notice. As discussed above, Enomoto lacks all claimed features. Even with the Official Notice, there is no showing the specifics of a method for providing computer suggested image processing on a first image by identifying and suggesting by a computer one of a plurality of product attributes of an image-based product incorporating at least a portion of the first image; and automatically selecting a new value for the computer suggested product attribute. Hence, the references singly or in combination cannot render independent claim and those dependent therefrom obvious.

Per MPEP 706.02(j): Contents of a 35 U.S.C. 103 Rejection

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP Section 2143 - Section 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP Section 2144 - Section 2144.09 for examples of reasoning supporting obviousness rejections.

Applicants submit that there is no suggestion to modify Enomoto to arrive at the invention as claimed. There is no reasonable expectation of success since. Moreover, the references singly or in combination, does not teach or suggest all the claim limitations in the independent claims as well as each dependent claims. Since the teaching or suggestion to make the claimed combination and the reasonable expectation of success is not found in Enomoto, there is an inference that it came from Applicants' disclosure.

In sum, since none of the references show the claimed elements recited in the claims, Applicant submits that they cannot render obvious independent claim 52. The dependent claims are allowable since they depend from allowable independent claims.

CONCLUSION

Applicants respectfully submit that all claims are in condition for allowance. Withdrawal of the rejection is respectfully requested. If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

Bao Tran

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